

Appln No. 09/693,219
Amdt. Dated May 12, 2006
Response to Office Action of March 27, 2006

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REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated March 27, 2006.

Claims Amendments

Claim 1 has been amended to specify the additional steps of: computing a difference between the digital image of the document and a rendered image determined from the stored data; determining image data for the second markings using the computed difference; and archiving the image data for the second markings with the stored data. Basis for this amendment can be found at page 23, lines 6-8 & lines 14-17 of the specification. A corresponding amendment has been made to claim 18.

Claim Rejections - 35 USC § 103(a)

The Applicant contests the Examiner's assertion that the present invention would have been obvious to the skilled person in view of Mori combined with Dymetman.

Neither Mori nor Dymetman teaches the steps of the invention as now claimed.

As explained at page 23 of the specification, by computing a difference, determining image data for the second markings and archiving this image data, the options available to the user are increased. The user can choose not to duplicate the 'second visible marking not associated with digital ink' (as claimed in claim 1). However, with the image data for the second visible markings computed and archived, the user has the option of printing or accessing the second visible markings at a later point in time. Moreover, with this image data archived in this way, the second visible markings may be printed separately or together with the other markings on the document as they originally appeared.

Neither Mori nor Dymetman provides this level of versatility to the user, because Mori and Dymetman do not teach separately archiving image data for second visible markings not associated with digital ink.

In the case of Mori, visible markings associated with digital ink are not taught at all, and so Mori has no motivation for determining and archiving separately the second visible markings specified in claim 1 of the present application.

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In the case of Dymetman, the transmission of a fax (column 22. lines 12-23) does not duplicate markings not associated with digital ink. However, these markings are not computed and archived separately by Dymetman. Such markings are effectively 'invisible' to Dymetman's system because they are not written by Dymetman's marking device. Therefore, image data for these markings is not computed and this image data is not archived for future access, if required. The invisibility of such markings in Dymetman's system means that they are lost forever once a hardcopy is destroyed.

Since neither of the cited documents suggests the steps specified in claim 1, it submitted that the present invention is not obvious in view of Mori and Dymetman.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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